

## **REMARKS**

Claims 1-27 are pending in the application, of which Claims 1, 4-6, 17-19, 21-25 and 27 have been withdrawn. The Applicants reserve the right to further prosecute the subject matter of the withdrawn and cancelled Claims in a divisional, continuation, continuation-in-part application at a later time. The Specification has been amended to include a "Statement Regarding Federally Sponsored Research or Development."

Claims 1, 4-5, 17, 21 and 23 have been amended. No new matter has been added.

In the Office Action, Claims 1, 4-6, 17-19, 21-25 and 27 have been rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. In particular, the Examiner alleges that the Claims are directed to a process for converting fatty acid to its corresponding dicarboxylic acid using a genus of POX 4 promoters but provides only a single representative, the *C. tropicalis* POX4 promoter. Although the Applicants respectfully disagrees with the Examiner, in an effort to advance the prosecution of some of the subject matter of the present application, the Applicants have amended the Claims to use the *C. tropicalis* POX4 promoter.

As acknowledged by the Examiner, the specification teaches the structure and function of the *C. tropicalis* POX4 promoter and therefore the specification provides written description for the same. By way of this application, the pending Claims have been amended to use the *C. tropicalis* POX4 promoter and therefore are fully supported by the specification. Claims 18, 19, 22, 24 and 25 have been cancelled and therefore the rejection as for these Claims is now moot. In view of the foregoing, the Applicants respectfully request that the rejection of Claims 1, 4-6, 17-19, 21-25 and 27 rejected under 35 U.S.C. § 112, first paragraph, for failing to comply with the written description requirement be reconsidered and withdrawn.

In the Office Action, Claims 1, 4-6, 17-19, 21-25 and 27 have been rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. In particular the Examiner alleges that the Claims are directed to a process for converting fatty acid to its corresponding dicarboxylic acid using a genus of target genes involved in dicarboxylic acid production, but provides the structure of only three representative species of such genes, namely the *C. tropicalis* CYP52A2A gene, the *C. tropicalis* CYP52A5A gene, and the *C. tropicalis* NCP1B gene. Although the Applicants respectfully disagrees with the Examiner, and believe that enough information is provided to provide written description for the genus claimed, in an effort to advance the prosecution of some of the subject matter of the present application the Applicants have amended the Claims to use the *C. tropicalis* NCP1B gene.

As acknowledged by the Examiner, the specification teaches the structure and function of the *C. tropicalis* NCP gene and in particular the *C. tropicalis* NCP1B gene and therefore the specification provides written description for the same. By way of this application, the pending Claims have been amended to recite the *C. tropicalis* NCP gene and/or the *C. tropicalis* NCP1B gene and therefore are fully supported by the specification. Claims 18, 19, 22, 24 and 25 have been cancelled and therefore the rejection as for these Claims is now moot. In view of the foregoing, the Applicants respectfully request that the rejection of Claims 1, 4-6, 17-19, 21-25 and 27 rejected under 35 U.S.C. § 112, first paragraph, for failing to comply with the written description requirement be reconsidered and withdrawn.

In the Office Action, Claims 1, 4-6, 17-19, 21-25 and 27 have been rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to enable the subject matter as claimed. In particular, the Examiner acknowledges that the specification is enabling for methods of converting a fatty acid to its corresponding dicarboxylic acid using a *C. tropicalis* POX4 promoter fused to at least one of the *C. tropicalis* CYP52A2A gene, the *C. tropicalis* CYP52A5A gene, and the *C. tropicalis* NCP1B gene. Although the Applicants respectfully disagree with the Examiner, in an effort to advance the

prosecution of some of the subject matter of the present application, the Applicants have amended the Claims to use the *C. tropicalis* POX4 promoter fused with the *C. tropicalis* NCP gene and/or *C. tropicalis* NCP1B gene.

As acknowledged by the Examiner, the specification is enabling for methods of converting a fatty acid to its corresponding dicarboxylic acid using a *C. tropicalis* POX4 promoter fused to at least one of the *C. tropicalis* CYP52A2A gene, the *C. tropicalis* CYP52A5A gene, and the *C. tropicalis* NCP1B gene. By way of this application, the pending Claims have been amended to use the *C. tropicalis* NCP gene and/or the *C. tropicalis* NCP1B gene and therefore are fully enabled by the specification. Claims 18, 19, 22, 24 and 25 have been cancelled and therefore the rejection as for these Claims is now moot. In view of the foregoing, the Applicants respectfully request that the rejection of Claims 1, 4-6, 17-19, 21-25 and 27 rejected under 35 U.S.C. § 112, first paragraph, for lack of enablement be reconsidered and withdrawn.

Turning to the rejections of the Claims on the merits.

In the Office Action, Claims 1, 4-6, 17-18, 21-24 and 27 have been rejected under 35 U.S.C. 102(b) as being anticipated by Wilson et al. (WO 00/20566- herein WO '566). As acknowledged by the Examiner at page 11 last full paragraph of the Office Action, Wilson does "not teach *Candida tropicalis* POX4 promoter." Claims 18, 22, 24 and 25 have been cancelled and therefore the rejection as for these Claims is now moot. In view of the fact that the remaining Claims in this rejection have been amended to use the *C. tropicalis* POX4 promoter, Applicants respectfully request that the rejection of Claims 1, 4-6, 17, 21, 23 and 27 under 35 U.S.C. § 102(b) be reconsidered and withdrawn.

Similarly, Claims 4-6, 17-18, 21-24 and 27 have been rejected under 35 U.S.C. 102(a or e) as being anticipated by Wilson (US Patent No. 6,331,420 - here US '420). At page 11 of the Office Action, the Examiner also acknowledged that US ' 420 does

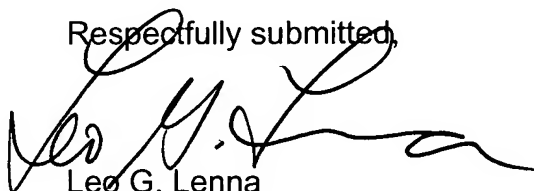
"not teach *Candida tropicalis* POX4 promoter." Claims 18, 22, 24 and 25 have been cancelled and therefore the rejection as for these Claims is now moot. In view of the fact that the remaining Claims in this rejection have been amended to use the C. *tropicalis* POX4 promoter, Applicants respectfully request that the rejection of Claims 1, 4-6, 17, 21, 23 and 27 under 35 U.S.C. § 102(a or e) be reconsidered and withdrawn.

Finally, in the Office Action, Claims 19 and 25 have been rejected under 35 U.S.C. §103(a) as being unpatentable over either WO '566 or US '420 in view of OKAZAKI et al. By way of this amendment, Claims 19 and 25 have been cancelled and therefore this rejection is now moot.

In view of the foregoing amendments and remarks, Applicants respectfully assert the Claims are now in condition for allowance and allowance of all Claims is respectfully requested.

This is in response to the Office Action mailed July 13, 2006, which set a shortened statutory period of three months for response. Accordingly, this response is filed timely upon mailing with an executed Certificate of Mailing on or before October 13, 2006.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Leo G. Lenna", is written over the typed name.

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